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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,685	10/15/2003	Anthony Costa	0299568-0417	7079

7590 07/13/2006

IP Department  
Schnader Harrison Segal & Lewis LLP  
Suite 3600  
1600 Market Street  
Philadelphia, PA 19103

EXAMINER

SILVERMAN, ERIC E

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/685,685	COSTA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric E. Silverman, PhD	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2-9-04</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

### **DETAILED ACTION**

Claims 1 – 17 are pending in this action.

#### ***Specification***

The use of the trademarks ACULYN 44 and LIPOSORB L-20 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “initial viscosity”. It is unclear what is meant by “initial” in this context, since this is a composition claim without method steps that might change the viscosity.

The remaining claims are rejected at least for depending on claim 1, thereby incorporating the indefinite limitation thereof.

Claims 4, 15, and 17 recite the trademarks ACULYN 44 and LIPOSORB L-20.

The use of a trademark renders a claim indefinite, since a trademark only specifies the source of a material, not the nature of the material itself.

Claim 12 recites the limitation "said oil" in claim 11. There is insufficient antecedent basis for this limitation in the claim. For the purpose of compact prosecution, this claim is interpreted as depending on claim 10.

Claim 16 recites "glycol-comprising phase". This term is unclear, since glycols may be miscible with water, and need not constitute a separate phase. Clarification is requested.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 – 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 625 034 B1, of record.

The '034 reference discloses hydrogels made of a cross-linked water swellable (that is, dispersible but not soluble) PVP (paragraphs 009 – 0010). A medicament is also included (paragraphs 0022 – 0025 and 0036 – 0040). The viscosity is deemed inherent. With regard to the limitation of claim 11 that the subject be a fish, applying the composition to a fish is an intended use, and is not afforded patentable weight in a claim drawn to a composition.

Claims 1 – 3, 5, 6 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,729,190 to Lee.

Lee discloses a hydrophobicly bodified ethoxylated polyurethane that is incorporated into a hydrogel (Example 26). The hydrogel is used in medicament formulations (Examples). The viscosity is deemed inherent. With regard to the limitation of claim 11 that the subject be a fish, applying the composition to a fish is an intended use, and is not afforded patentable weight in a claim drawn to a composition.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 – 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,074,438 to Lim et al.

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Lim teaches hair-treatment compositions, and suggests formulating such as gels (col. 7, lines 40 – 56). Lim suggests the use of ACULYN-44 as a thickener for the composition. The use of this agent is motivated by the teaching that it is functional at low concentrations. With regard to claim 11, the subject being a fish is deemed to be a future intended use, and as such is not afforded patentable weight in a composition claim.

Lim does not explicitly teach a composition containing this agent.

However, it would be prime facie obvious to a person of ordinary skill in the art at the time of the invention to make a gel-composition containing ACULYN-44, since such is suggested by Lim. Because Lim gives considerable guidance as to how to make such compositions, the artisan would have a reasonable expectation of success.

Claims 6 – 10, and 12 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 625 034 B1 in view of US 4,551,332 to Stillman.

Some of the teachings of the '034 reference are discussed above. The '034 reference also teaches a wound healing/burn composition (paragraphs 0036 – 0040).

The '034 reference does not teach organic oils.

Stillman teaches adding clove oil to wound healing compositions in order to facilitate the wound protective properties thereof (col. 9, line 59 – col. 10 line 35). In particular, clove oil is taught for its high concentration of phenols (anti-oxidants). A concentration of about 1.5% is taught to be ideal.

As such, it would be prime facie obvious to a person of ordinary skill in the art at the time of the invention to add clove oil to the composition of '034. The motivation to

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do so comes from Stillman, who teaches this ingredient to improve wound protective properties. Since Stillman teaches how much to use the artisan would enjoy a reasonable expectation of success.

### **Conclusion**

No claims are allowed. No claims are free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Art Unit 1615



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